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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,718

01/28/2005

Minoru Moriya

2005-0136A

7474

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7590

03/12/2008

WENDEROTH, LIND & PONACK, L.L.P.

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WASHINGTON, DC 20006-1021

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

03/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,718	Applicant(s) MORIYA ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 20 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :January 28, 2005, April 27, 2005 and October 1, 2007.

DETAILED ACTION

Claims 1-27 are pending in the application.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-11, 14-19 and 21-26 - drawn to products) in the reply filed on December 7, 2007 is acknowledged. The traversal is on the ground(s) that in the Restriction Requirement the outlined groups do not cover all of the claimed subject matter. This is not found persuasive because, as acknowledged by Applicant, the Restriction Requirement did state that the groupings of invention did not cover all of the claimed subject matter and the reasoning behind not grouping all of the claimed subject matter (see second paragraph on page 4 of the Restriction dated November 7, 2007). Applicant suggested adding an additional group to cover all of the remaining subject matter. In response, grouping the remaining subject matter in a single group

is not acceptable because many inventions would be embraced by this single group.

The requirement is still deemed proper and is therefore made FINAL.

Subject matter not embraced by elected Group I and Claims 12, 13, 20 and 27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 7, 2007.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on January 28, 2005, April 27, 2005 and October 1, 2007.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11, 14-19 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 14, the use of "general" (line 3 of claim) makes it appear that Applicant is also claiming compounds not embraced by formula {I}. It is suggested that "general" be deleted from the claims.

In claim 1, it is not clear why there is a bracket before "[in which B¹, B² and B³ ...".

In claim 1, under the definition of R¹ and R², the numbering of the various substituents representing these variables is confusing. For example, where are definitions 1) and 2)? Further, why is the numbering 3), 4), 3)?

In claim 1, under the definition of R¹ and R², there is a valence problem when Y represents -CH-.

In claim 1, under the definition of W, there is a valence problem when the C₂-C₄ alkylene and alkenylene

is substituted with an oxygen atom. See claim 7 for same.

In claim 1, under the definition of W, it is unclear what is meant by the phrase "whose carbon in the main chain".

Claim 1 does not conform to M.P.E.P. 608.01(m) since each claim must end with a period and no other periods may be used elsewhere in the claims except for abbreviations {i.e., "alkylamino." - page 86 at the end of Group α definition}.

In claims 1 and 14, under the definition of W, "linker" should be changed to "a linker".

In claim 1, under the definition of W, it is unclear of what is a linker and the radicals which make up the linker.

In claim 1, after Group γ , the bracket should be deleted.

In claims 9, 10, 22 and 23, an "and" should be added before the last substituent listed.

Claims 9 and 10 lack antecedent basis from claim 1 because it does not state that the rings represented by the W variable can be substituted.

In claim 14, the bracket before "[in which" and the bracket after "Claim]" are both unnecessary and should both be deleted.

Compound Claim 14 improperly depends from composition claim 1.

Claims 21 and 22 improperly depend from withdrawn claim 20 and therefore lacks antecedent basis since claim 20 does not embrace aromatic nitrogen containing heterocycles.

In claim 25, the phrase "represented by the general formula [I-1]" should be deleted and a comma should be added after each compound listed (except for the last compound).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is

(571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton, Ph.D./
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

March 12, 2008